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| 09/843,106 | 04/25/2001 | David Robert Dudek | TS9244 (US) | 1059 |

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| EXAMINER |
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TREMBLAY, MARK STEPHEN

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| ART UNIT | PAPER NUMBER |
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2876

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,106

Applicant(s)

DUDEK ET AL.

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Applicant: Dudek et al.

Filing date: 4/25/2001

Claim Rejections - 35 USC § 112

Claims 1-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The claims use the term "intelligent". Applicant has pointed to page 5 for a supporting description, and antecedent basis in the specification. It is not enough to have a description in the specification of a term. The description must be definite, in order to constitute a definition. The description of the Applicant's use of the term "intelligent" is not definite, since it uses open ended exemplary language, "and/or" terminology, non-equivalent alternatives, relative terminology, and vague and indefinite concepts such as "management of the supply chain, that is to say, optimizing supply chain responsiveness." The sentence following the description of what is "intelligent" states, "Said identification means may be of any kind commonly used in the art."

A second problem with the Applicant's amended use of the term "intelligent" is that the specification passage pointed out by Applicant states that "Identification means in the form of, for example, electronic tags allow a reader or scanner to read data from the tag and/or write data to the tag. The reusable container then essentially becomes intelligent." It is unclear in the amended claim language how the juxtaposition of the terms "electronic" and "intelligent" is intended by Applicant to be understood. This passage leaves open the possibility that the scanner may only read data, since that is one of the possible interpretations of Applicant's description. Later, in the specification, Applicant mentions "resistance tagging, optical tagging, and transponder tagging". This language is mirrored in dependent claims 8 and 19. Since electro-optical is one of the choices, and the example given is "a series of slots are moulded into the reusable container", it would seem that Applicant contemplates passive electro-optical reading to be included within the definition of "electronic intelligent tag". If Applicant did not wish to include this form of tagging within the definition, the term "transponder tagging" was available. Since a bar code is well known a passive electro-optical tag which allows a reusable container to become an "intelligent" container, since it can encode any specific consumer data, such as buying

frequency, etc., it would appear to qualify. Thus, the essential indefiniteness here is that passive electro-optical tags appear to be included, whereas the face value of the phrase "electronic intelligent tag", absent the supporting description, and claims 8 and 19, would appear to exclude passive electro-optical tags (such as a series of molded slots or a bar code).

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claims 1-4, 8-15, and 19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent #4,236,559 to Archbold ("Archbold" hereinafter). Archbold discloses a reusable container, which comprises therein one or more electronically and/or optically readable information means.

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Re claim 12, it is taught in the disclosure that the ID on bag is viewable by a bus driver, who can read the optical information (inherent in the disclosure of a "bus driver" who must also be able to read road signs and pass a driver's test), store it, and is capable of being interrogated to extract and optionally process the information. Applicant's broadly recited claims do not preclude this interpretation.

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Claims 1-4, 8-15, and 19-21 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent #6,092,731 to Smith ("Smith" hereinafter). Smith discloses a reusable container (figs. 8, 9), which comprises therein one or more electronically and/or optically readable information means.

Re claim 4, Figure 8 shows a fold along the side of the container.

Claims 1, 8-12, 17, 19-20 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent #4,809,342 to Kappner ("Kappner" hereinafter). Kappner discloses a reusable container 11, which comprises therein one or more electronically and/or optically readable information means (see figures 3-23).

Claims 1 and 8-11 are rejected under 35 U.S.C. § 102(b) as being anticipated by German Patent Application #DE 4439914 A1 to Muller ("Muller" hereinafter). Muller discloses a reusable container 14, which comprises thereon one or more readable identification means, the identification means comprising an electronic intelligent tag 22.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6 and 8-11 are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent #6,391,136 to Stickelbrocks ("Stickelbrocks" hereinafter). Stickelbrocks discloses an intelligent electronic tag (see col. 4, lines 57-61) designed for attachment to luggage, which are

known to be reusable containers.

Re claims 2-6, Official Notice is taken that luggage having portions which are collapsible bags or sachets, having collapsible portions pleated, fluted, folded, or using expandable elastomeric material, or having a rigid upper portion, are old and well known in the art. See In Re Malcolm 1942 C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the tag taught by Stickelbrocks with all manner of luggage, including that well known in the art, because the tag taught by Stickebrocks is designed for generic use with all luggage that might be presented at an airline checkin counter, including any luggage known in the art.

Re claim 10, see column 1, line 29.

Re claim 11, the identification means for lugagge clearly comprises data based on use of the reusable container, at least including data equivalent to or interpretable as who is using the reusable container.

Claims 1-21, are rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent #5,067,636 to Pfeiffer et al. ("Pfeiffer" hereinafter) in view of German Patent Application #DE 4439914 A1 to Muller ("Muller" hereinafter). Pfeiffer discloses a reusable container with one or more fill apertures and one or more dispense apertures, the fill aperture being remotely positioned on the container in relation to the dispense aperture. Pfeiffer does not disclose any means of identifying the container or it's contents. Muller discloses a means for identifying a refillable container and it's contents for refilling and tracking purposes. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the container taught by Pfeiffer with the system for filling and tracking reusable containers as taught by Muller because this would allow the container taught by Pfeiffer to be automatically identified and tracked through the whole service life of the container as taught by Muller.

Re claims 4-5 and 15-16, neither reference expressly teaches a folded side wall or an expandable elastomeric material. Official Notice is taken that folded side walls and expandable elastomeric materials is old and well known in the container art. See In Re Malcolm 1942

C.D.589:543 O.G. 440. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide embodiments of the combined teachings with folded side walls because this would allow the container to expand and contract in a regular pattern, as required, and allow for the convenient storage of stock for making the container walls.

5 It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the collapsible portion taught by Pfeiffer of an elastomeric material because these materials are known to be tough and resilient, and the equivalent of e.g. plastic materials.

Claims 5 and 16, are rejected under 35 U.S.C. § 103 as being unpatentable over Smith. Smith discloses the features of the invention as described above, and further discloses that a variety of materials can be used to make the bag, but does not disclose an elastomeric material. Elastomeric materials are old and well known in the art. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the bag taught by Smith using an elastomeric material, because these materials can expand and contract on the basis of the contents placed in them, allowing them to use less space when not completely filled, and more space as necessary.

Response to Arguments

As explained in the 35 U.S.C. §112, second paragraph rejection, Applicant's use of the term "electronic intelligent tag" is indefinite and ambiguous. It is unclear that Applicant's description of this term excludes bar codes, particularly in light of the inclusion in claims 8 and 19 of the passive electro-optical embodiment. Bar codes can encode any information desired. The information in a bar code can be downloaded and updated. A bar code can be updated in several ways known in the art. They can be reprinted with new information. They can be appended with new information. The information they encode can be used as a pointer to updated information in a central location, such as in the classic Price Look-Up (PLU) arrangement, or standard package tracking. This understanding of bar codes comports with Applicant's general description of the invention at page 15, where Applicant suggests the information is stored on a computer, not on the tag itself, as Applicant has argued. The

description at pages 5-6 do not appear to rule out the use of bar codes in an intelligent reusable container.

Applicant argues that the numerous examples on page 5 as to what information an electronic intelligent tag can provide distinguish the invention over the cited references. The Examiner respectfully disagrees. Bar codes allow for the "collection and recordation of this type of information on the reusable container itself that can be read and downloaded and updated for various uses." Numerous known types of bar codes allow the recordation of any known type of information. Known printed bar codes are updatable with known printers in a fashion entirely equivalent to known RFID tags being updatable with known RFID tag writers. Applicant has not pointed out any type of information which cannot be contained by known bar codes.

Examiner, in light of the ambiguities of Applicant's amendments, has also rejected the claims under alternative prior art, including Muller and Stickelbrocks. Stickelbrocks uses language similar to that used by Applicant, although Examiner does not concede that Stickelbrocks constitutes evidence that the amended language has a standard definition in the art. Stickelbrocks was located because Examiner keyword searched the relevant US patent database for the precise language used by Applicant, not because the language is pervasive and well defined in the art. Muller teaches the use of transponder tags in a manner analogous to Kappner.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final

action.

Voice

5 Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The
Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is
available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner,
Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning
10 PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or
(703) 308-4357.


MARK TREMBLAY
PRIMARY EXAMINER

January 13, 2003